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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,766	08/22/2001	Toru Ozaki	826.1742	6192
21171	7590	04/28/2008	EXAMINER	
STAAS & HALSEY LLP			DESHPANDE, KALYAN K	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			3625	
			MAIL DATE	
			DELIVERY MODE	
			04/28/2008	
			PAPER	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/933,766
Filing Date: August 22, 2001
Appellant(s): OZAKI ET AL.

Richard A. Gollhofer
(Reg. No. 31, 106)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 27, 2008 appealing from the Office action mailed July 24, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Art Unit: 3625

5,774,534

Mayer

6-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-9 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Sahota (Patent Application Publication No. 2002/0010928 A1).

Referring to claim 1. Sahota discloses a commerce information managing method for managing commerce information, comprising:

- Receiving a request to generate a commercial message broadcast and commercial message information relating to the commercial message broadcast from at least one of a merchandise producer and a service provider (Sahota: paragraph 0062, "The method and system provide an end-to-end framework for network operators and broadcasters to integrate seamlessly existing assets to generate new interactive advertising services.");

- Requesting a concurrent broadcast of the commercial message broadcast (Sahota: Fig. 1A, "TV Commercial **108**") and the commercial message information relating to the commercial message broadcast generated according to the commerce information (Sahota: Fig. 1A, "Internet Advertising Content **112**"), during a broadcast of a main program (Sahota: paragraph 0017, "In such a system, broadcasters or content providers can target specific users with interactive content (e.g., an advertisement banner) integrated with specific TV commercial content."); and
- Receiving at a broadcast reception terminal device of a client, as part of the commerce information, commercial message broadcast designation information contained in the commercial message information and designating at least the commercial message broadcast when the client sees the commercial message broadcast (Sahota: paragraph 0060), performs an instruction for displaying the commercial message information relating to the commercial message broadcast and purchases merchandise or a service in the commercial message information relating to the commercial message broadcast (Sahota: paragraph 0061).

Referring to claim 2. Sahota further discloses a method wherein said commercial message information contains at least one of a merchandise catalog, a merchandise guide book in which merchandise is classified based on a characteristic of each piece of merchandise (Sahota: paragraph 0043, "For example, advertising server **230** can store specific rules, which specify the

Art Unit: 3625

personalization of content for a particular user, i.e., providing a local restaurant advertisement content with a local TV commercial for the restaurant.”).

Referring to claim 3. Sahota further discloses a method wherein said commercial message information is described in an XML data format; and specific information contained in the commercial message information is distributed (Sahota: paragraph 0036).

Referring to claim 6. Sahota further discloses a method comprising analyzing data of the commerce information being managed; and transmitting an analysis result to the merchandise producer of the service provider (Sahota: paragraph 0041).

Referring to claim 7. Sahota further discloses a method wherein said commerce information contains any of information relating to merchandise or a service, attribute data of the client, and information about merchandise or a service purchased by the client (Sahota: paragraph 0036 and paragraph 0041).

Referring to claim 8. Sahota further discloses a method comprising distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service so that the client can receive a support of aftercare for the merchandise or the service (Sahota: Fig. 5B, “Help”).

Referring to claim 9. Sahota further discloses a method comprising assigning the client a service point based on the CM broadcast designation information, information about merchandise or a service purchased by the client, and attribute data of the client (Sahota: Fig. 5B, "Help").

Referring to claim 28. The limitations of claim 28 closely parallel those of claims 1-3 and 6-9. Claim 28 is rejected under the same rationale as set forth above in claims 1-3 and 6-9.

Referring to claim 29. The limitations of claim 29 closely parallel those of claims 1-3 and 6-9. Claim 29 is rejected under the same rationale as set forth above in claims 1-3 and 6-9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sahota (Patent Application Publication No. 2002/0010928 A1) in view of Mayer (U.S. Patent No. 5,774,534).

Referring to claim 4. Sahota teaches a method according to claim 1 as indicated supra. Sahota does not specifically teach a method wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is bought from the broadcasting station. Mayer teaches a method, wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is bought from the broadcasting station (Mayer: column 15, lines 61-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Sahota to have included the teachings of Mayer in order to provide a seamless integration of existing assets to generate new interactive commercial advertising services (Sahota: paragraph 0005).

Referring to claim 5. Sahota in view of Mayer discloses a method according to claim 4 as indicated supra. Sahota further discloses a method wherein said broadcast program is changed based on at least one of merchandise inventory information about the merchandise producer and service providing information about the service provider (Sahota: paragraph 0042).

(10) Response to Argument

Appellants argue:

- 1) Sahota fails to teach "commercial message broadcast designation information...designating at least the commercial message broadcast" as per claims 1 and 4-5.
- 2) Sahota fails to teach "commercial message broadcast designation information" is received "at a broadcast reception terminal...as part of the commerce information" as per claims 1, 4-5, and 29.
- 3) All of the limitations in claim 1 are functional limitations.
- 4) Sahota fails to teach "distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service" as per claim 8.
- 5) Sahota fails to teach "a management unit receiving commercial message broadcast designation information contained in the commercial message information and designating at least a commercial message broadcast" as per claim 28.

1) Sahota explicitly teaches "commercial message broadcast designation information...designating at least the commercial message broadcast".

Appellants allege in their arguments that paragraphs [0057-0060] are the most pertinent to the present invention and these paragraphs fail to teach this specific limitation. Examiner has previously noted that paragraph [0061] is the most relevant teaching to this limitation as it explicitly teaches that a user can launch interactive content from the commercial that includes launching the retailer's website. This is exactly the same as "commercial message broadcast

designation information" (where providing the retailer website URL is the designation information) and "designating at least the commercial message broadcast" (where embedding the retailer website URL is the designation of the message). Appellants merely allege that this is similar to what's being claimed in the present invention (see Appeal Brief page 5 last sentence to page 6 first sentence) without actually stating what these alleged differences are. Examiner submits that this is a direct reading on the claims of the present invention. Appellants' arguments regarding several other passages of Sahota failing to teach this limitation are irrelevant since paragraph [0061] directly teaches this limitation. Appellants further argue that Sahota fails to teach the "multiplexer/encoder inserts the URL into the broadcast TV commercial" (see Appeal Brief page 6 second paragraph), however, nowhere in claim 1 is it recited that "multiplexer/encoder inserts the URL into the broadcast TV commercial". Examiner notes that since this feature is not claimed, an argument that alleges Sahota fails to teach this feature is irrelevant.

In summary, Examiner maintains that at operation **445** (Sahota: paragraph 0061), a user of TV **104** can launch interactive services by accessing interactive content **510**. For example, a user accessing interactive content **510** will begin interacting with a website as shown in FIG. 5B related to the clothing retailer. The website is designated based on the commercial message. Sahota's main focus is a method and system for integrating Internet advertising with television commercials. This integration would not be possible without commercial message broadcast designation information. Sahota provides an end-to-end

framework for network operators and broadcasters to integrate seamlessly existing assets to generate new interactive advertising services (Sahota: paragraph 0062). Examiner submits this is a direct reading on the present invention and Examiner's rejection should be affirmed.

2) Sahota explicitly teaches "commercial message broadcast designation information" is received "at a broadcast reception terminal...as part of the commerce information".

Examiner is unclear as to exactly what Appellants' allege is missing from Sahota. Sahota explicitly teaches "commercial message broadcast designation information" (as discussed above) is received "at a broadcast reception terminal...as part of the commerce information" (see Sahota paragraph [0061] and figure 1A). Sahota paragraph [0061] and figure 1A describe a set-top box that receives broadcast designation information, as conceded by Appellants (see Appeal Brief page 7 last paragraph). Appellants concede that Sahota teaches this feature and then conclusively state that Sahota fails to teach this feature. The Sahota set-top box is a broadcast reception terminal device of the client, and as such, Examiner maintains that Sahota directly reads on this limitation. Thus, Examiner maintains the previously asserted rejection is proper and should be affirmed.

3) All of the limitations in claim 1 are not functional limitations.

Examiner first notes that all of the claimed limitations are anticipated by the prior art and has merely stated that the data elements contained in the claimed information is non-functional. Examiner submits that although the prior

Art Unit: 3625

art clearly anticipates all of the claimed data elements, the claimed data elements are not to be given patentable weight since the claimed data elements are non-functional descriptive material.

Examiner specifically points to the recited claim language in claim 1 (third limitation) that reads "...commercial message broadcast designation information *contained* in the commercial message information". The commercial message broadcast designation information is merely printed material contained in the commercial message information. As such a data element, the commercial message broadcast designation information is merely nonfunctional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

4) Sahota fails to teach "distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service" as per claim 8.

Appellants specifically argue that the term "shop" must refer to a physical location (i.e. "a brick and mortar store") (see Appeal Brief page 9 paragraph 3). Examiner submits that the term shop is broad enough to include all type of shops, including online stores. A further limitation of this term is not found in the

claims and Examiner notes that although the claims are read in light of the specification, limitations from the specification are not read in to the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, Sahota explicitly reads on the broad claim language recited in the present invention and the previously asserted rejection should be affirmed.

5) Sahota explicitly teaches “a management unit receiving commercial message broadcast designation information contained in the commercial message information and designating at least a commercial message broadcast” as per claim 28.

Appellants' arguments with respect to claim 28 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant merely state the claim language of claim 28 and merely allege that Sahota fails to teach this claim language without providing any evidence supporting this allegation. Examiner maintains that the previously asserted rejection is proper and thus should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3625

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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